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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/277,213

03/26/1999

YASUSI KOBAYASHI

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7590

07/02/2002

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EXAMINER

HOM, SHICK C

ART UNIT

PAPER NUMBER

2661

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/277,213

Applicant(s)

KOBAYASHI ET AL.

Examiner

Shick C Hom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-95 is/are pending in the application.
- 4a) Of the above claim(s) 1-42, 45, 49, 51, 52 and 55-91 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 46-48, 53, 54 and 94 is/are allowed.
- 6) ☒ Claim(s) 50, 92, 93 and 95 is/are rejected.
- 7) ☒ Claim(s) 43 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/518,110.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/29/02 have been fully considered but they are not persuasive.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119 (a)-(d). The certified copy has been filed in parent Application No. 08/518,110, filed on 08/21/1995.

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not indicate that foreign priority is claimed as indicated in page 4 lines 7-10 of the 3/29/02 amendment.

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Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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6. Claims 92 and 93 are rejected under 35 U.S.C. 102(e) as being anticipated by Thor.

Thor discloses all the subject matter now claimed. Note col. 5 lines 29-55 which recite the storing means supplying control information contained in the data frames to a control processor that updates contents of the storing means in a packet switching network clearly anticipate the switch station which exchanges a packet with a predetermined format, and the control processor controlling the switch station as in claim 92. Further, Thor recites that the data receiving means converting data received from a transmitting data terminal into a data packet with an address field and data transmitting means for converting the data packet read into data transmitted to a receiving data terminal clearly anticipate the interface unit converting a data format of the control information into data format which the switch can exchange and the intra-station device performing a communication operating according to the control information as in claim 92. Fig. 1 which shows the field diagram of the frame relay high-level data-link control format for the frame relay protocol defined in standards listed in Table 1 clearly anticipate the control information being communicated according to link access protocol as in claim 93.

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 95 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe in view of Nelson et al.

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Watanabe discloses nearly all the subject matter now claimed. Note Watanabe which recite the program storage means storing the program having loopback execution instruction provided in the controller whereby using the discrimination means faulty local station is disconnected from the network for the purpose of providing loopback testing easily clearly anticipate the memory storing a program for loopback test and the control processor performing the loopback test by executing the program as in claim 95 and the communication device connected to the control processor for a loopback test as in claim 50.

Watanabe did not recite the switch station which exchanges packet including the output highway and input highway being connected to a loopback device during the loopback test as in claim 95.

Nelson et al. teach that it is known to provide loopback capability that permits the line output to be electrically connected to the line input so that in the loopback mode all the traffic that would have gone out to the station is looped back and is received by the input line control circuitry hence in the loopback mode it is possible for the PLS to act as a highway-to-highway switch where it picks up one or two time slots from the receive highways and puts them on different time slots on the

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transmit highways as set forth at col. 20 lines 24-46 in the field of digital and multiplex communications for the purpose of providing variable bandwidth switching between nodes of a distributed switch so as to maximize total traffic capacity which clearly anticipate the switch station which exchanges packet including the output highway and input highway being connected to a loopback device during the loopback test as in claim 95.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the switch station which exchanges packet including the output highway and input highway being connected to a loopback device during the loopback test as taught by Nelson et al. to the device of Watanabe because Nelson et al. teach the desirable advantage of providing variable bandwidth switching between nodes of a distributed switch so as to maximize total traffic capacity and said maximizing traffic capacity being desirable to achieve more efficient system operation in Watanabe.

Allowable Subject Matter

9. Claims 46-48, 53, 54, and 94 are allowed.

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10. Claims 43 and 44 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
Narasimhan et al. disclose a time-slot assigner multiplexer.

12. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal
Park II, 2121 Crystal Drive, Arlington. VA., Sixth
Floor (2600 Receptionist at (703) 305-4750).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shick Hom whose telephone number is (703) 305-4742. The examiner's regular work schedule is Monday to Friday from 8:00 am to 5:30 pm EST and out of office on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas Olms, can be reached at (703) 305-4703.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



**DANG TON
PRIMARY EXAMINER**

SH

June 18, 2002